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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
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8 *Ex parte* RIK SAGAR
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11 Appeal 2008-004134
12 Application 09/966,613
13 Technology Center 3600
14

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16 Decided: August 26, 2009
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20 *Before:* MURRIEL E. CRAWFORD, ANTON W. FETTING, and BIBHU
21 R. MOHANTY, *Administrative Patent Judges.*

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23 CRAWFORD, *Administrative Patent Judge.*
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26 DECISION ON APPEAL
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STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 (2002) from a final rejection of claims 1 to 25. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

Appellant invented an automatic booking system for guest accommodations for reserving guest accommodations for the customer's use during a later period of time (Spec. 1).

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Lee	US 4,899,373	Feb. 6, 1990
Daum	US 2003/0109938 A1	Jun. 12, 2003
Sunyich	US 2003/0149576 A1	Aug. 7, 2003

The Appellant relies upon the following evidence:

Affidavit of Larry Liberchuk, filed under 37 C.F.R. § 1.131 with accompanying exhibit, Abstract ID 700713.

Claim 1 under appeal reads as follows:

1. An automated booking system for guest accommodations, comprising:
a guest accommodation which can be automatically booked by the system and used by a customer for a period of time;
a provider network of a guest accommodations reservation provider having a data base for customer preferences;
reserving means for communication between a home network and the provider network for reserving the guest accommodations for a period of use;
preference transmission means for transmitting customer preferences from a data base of the home network to the data base of the provider network; and
means for accessing the provider data base for providing the accommodations depending on the customer preferences.

1 The present Declaration is being submitted
2 under 37 CFR § 1.131 to establish a date of
3 invention of the subject matter of claims 1-25 as
4 now pending before the U.S. Patent and
5 Trademark Office. The present Declaration is
6 further being submitted to establish a date of
7 invention of the subject matter set forth in the
8 specification and drawings as originally filed
9 before the U.S. Patent and Trademark Office on
10 September 27, 2001.

11 Prior invention of the 09/966,613 patent
12 application is at least as of April 30, 1999, because
13 the inventor conceived of the present subject
14 matter at least as of that date. A copy of the
15 evidence supporting at least the above date is
16 enclosed herewith: the inventor submitted written
17 invention disclosure materials to the patent
18 department of Koninklijke Philips Electronics
19 N.V. with the intention of filing for patent
20 protection. This disclosure was followed by a due
21 diligence leading to a subsequent filing of the
22 application.

23 A paper entitled "Abstract ID 700713" was attached to the
24 Declaration. The paper indicates a short title "Service for Transfer Of User-
25 Preferences From Home to Hotel," and ID Date of April 30, 1999, Inventor
26 Rik Sagar and the company Philips Applied Technologies Sunnyvale.

27 Sunnyich discloses an automated booking system for check-in and
28 electronically setting preferences to a hotel room [0002]. The preferences
29 include temperature control, audible alarms, access to connecting rooms,
30 refrigerators, etc. [0015]. The system may utilize a proximity card that is
31 automatically scanned when the guest enters the hotel. The preferences of
32 the guests are stored in a database on the card [0026].

Daum discloses a home network that transmits commands between a source and appliances [0008].

PRINCIPLES OF LAW

Section 1.131

37 C.F.R. § 1.131 provides in pertinent part:

(a) When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.

Conception

The test for conception is whether the inventor had an idea that was definite and permanent enough that one skilled in the art could understand the invention; the inventor must prove his conception by corroborating evidence, preferably by showing a contemporaneous disclosure. An idea is definite and permanent when the inventor has a specific, settled idea, a

1 particular solution to the problem at hand, not just a general goal or research
2 plan he hopes to pursue. *Burroughs Wellcome Co. v. Barr Labs., Inc.*, 40
3 F.3d 1223, 1227-28 (Fed. Cir. 1994). It is well settled that in establishing
4 conception a party must show possession of every feature recited in the
5 claim. *Coleman v. Dimes*, 754 F.2d 353, 359 (Fed. Cir. 1985).

6
7 Anticipation

8 A claim is anticipated only if each and every element as set forth in
9 the claim is found, either expressly or inherently described, in a single prior
10 art reference. *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631
11 (Fed. Cir.), *cert. denied*, 484 U.S. 827 (1987). The inquiry as to whether a
12 reference anticipates a claim must focus on what subject matter is
13 encompassed by the claim and what subject matter is described by the
14 reference. As set forth by the court in *Kalman v. Kimberly-Clark Corp.*, 713
15 F.2d 760, 772 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984), it is only
16 necessary for the claims to “‘read on’ something disclosed in the reference,
17 i.e., all limitations of the claim are found in the reference, or ‘fully met’ by
18 it.” While all elements of the claimed invention must appear in a single
19 reference, additional references may be used to interpret the anticipating
20 reference and to shed light on its meaning, particularly to those skilled in the
21 art at the relevant time. See *Studiengesellschaft Kohle, m.b.H. v. Dart*
22 *Indus., Inc.*, 726 F.2d 724, 726-727 (Fed. Cir. 1984).

1 Obviousness

2 An invention is not patentable under 35 U.S.C. § 103 if it is obvious.
3 *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 427 (2007). The facts
4 underlying an obviousness inquiry include: Under § 103, the scope and
5 content of the prior art are to be determined; differences between the prior
6 art and the claims at issue are to be ascertained; and the level of ordinary
7 skill in the pertinent art resolved. Against this background the obviousness
8 or nonobviousness of the subject matter is determined. Such secondary
9 considerations as commercial success, long felt but unsolved needs, failure
10 of others, etc., might be utilized to give light to the circumstances
11 surrounding the origin of the subject matter sought to be patented. *Graham*
12 *v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). In addressing the findings of
13 fact, “[t]he combination of familiar elements according to known methods is
14 likely to be obvious when it does no more than yield predictable results.”
15 *KSR* at 416. As explained in *KSR*:

16 If a person of ordinary skill can implement a
17 predictable variation, § 103 likely bars its
18 patentability. For the same reason, if a technique
19 has been used to improve one device, and a person
20 of ordinary skill in the art would recognize that it
21 would improve similar devices in the same way,
22 using the technique is obvious unless its actual
23 application is beyond his or her skill. *Sakraida*
24 and *Anderson's-Black Rock* are illustrative - a court
25 must ask whether the improvement is more than
26 the predictable use of prior art elements according
27 to their established functions.

28 *KSR* at 417.

29 A prior art reference is analyzed from the vantage point of all that it
30 teaches one of ordinary skill in the art. *In re Lemelson*, 397 F.2d 1006, 1009

(CCPA 1968) (“The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain.”). Furthermore, “[a] person of ordinary skill is also a person of ordinary creativity, not an automaton.” *KSR* at 421.

On appeal, Applicants bear the burden of showing that the Examiner has not established a legally sufficient basis for combining the teachings of the prior art. Applicants may sustain their burden by showing that where the Examiner relies on a combination of disclosures, the Examiner failed to provide sufficient evidence to show that one having ordinary skill in the art would have done what Applicants did. *United States v. Adams*, 383 U.S. 39, 52 (1966).

ANALYSIS

Sunyich as prior art

We do not agree with the Appellant that the Examiner erred in determining that Sunyich is prior art. We agree with the Examiner that the Declaration under 37 C.F.R. § 1.131 filed by Appellant is not sufficient to remove Sunyich as prior art because the Declaration does not establish conception of the invention. The Declaration states that the invention was conceived at least as of April 30, 1999. However, the Declaration does not address the limitations of the claims. Likewise, the evidence filed along with the Declaration does not address the limitation of the claims. It is not clear what features the “invention” referred to in the Declaration and evidence includes. As such the Declaration and evidence does not establish

possession of every feature recited in the claim. As Appellant has not established conception, there is no necessity to address whether Appellant used due diligence to reduce the invention to practice.

Anticipation

We are not persuaded of error on the part of the Examiner by the Appellant's argument that Sunyich does not disclose the step of transmitting customer preferences from a data base of the home network to the data base of the provider network. The Appellant directs our attention to the embodiment in the Sunyich reference in which a user enters the preferences into a kiosk at the hotel or directly into the hotel data base. However, the Examiner relies on the embodiment in which a proximity card stores the preferences of the user. We agree with the Examiner that the proximity card, which the user carries, is a data base on a home network as broadly claimed.

Therefore, we will sustain the Examiner's rejection of claim 1 under 35 U.S.C. § 102(e) as being anticipated by Sunyich. We will also sustain this rejection as it is directed to claims 2 to 8 as the Appellant has not argued the separate patentability of these claims. In this regard, the statement in the Brief that claims 2 to 7 are patentable for the separate patentable subject matter recited is not considered an argument. We note that "[a] statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim." 37 C.F.R. § 41.37 (c)(1)(vii) (2008).

1 Obviousness

2 We will also sustain the Examiner's rejection of claims 9 and 10
3 because the Appellant makes the same argument in regard to this rejection as
4 we found unpersuasive in regard to the rejection of claim 1.

5 As to claim 11, we are persuaded of error on the part of the Examiner
6 by Appellant's argument that neither Sunyich nor Daum disclose
7 transmitting the user programmable settings of the home appliance of the
8 customer to the provider user data base. The Examiner has failed to show
9 where the prior art describes this limitation. While Daum does disclose a
10 home network with a source that controls the settings on appliances, Daum
11 does not disclose that the appliance settings are stored and then sent outside
12 the network. Likewise, while Sunyich discloses that a user can input user
13 settings into a hotel data base, there is no disclosure that the settings are
14 stored appliance settings.

15 Therefore, we will not sustain the Examiner's rejection of claim 11 or
16 claims 12 to 24 dependent thereon.

17 We will sustain the rejection as it is directed to claim 25 because
18 claim 25 does not recite that the user settings of the home appliance are
19 transmitted to the provider data base. Rather, claim 25 recites that the user
20 preferences are transmitted from the home network to the provider network.
21 As we found above, Sunyich discloses this subject matter.

22
23 **CONCLUSION OF LAW**

24 On the record before us, Appellant has shown that the Examiner erred
25 in rejecting claims 11 to 24. The Appellant has not shown that the Examiner
26 erred in rejecting claims 1 to 10 and 25.

DECISION

The Examiner's rejection of claims 1 to 10 and 25 is sustained. The Examiner's rejection of claims 11 to 24 is not sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

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